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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/512,130	10/13/2004	Manuela Niemeier	PAT-01027	7112

26922 7590 01/10/2007
BASF CORPORATION
1609 BIDDLE AVENUE
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EXAMINER

JACKSON, MONIQUE R

ART UNIT	PAPER NUMBER
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1773

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary	Application No.	Applicant(s)	
	10/512,130	NIEMEIER ET AL.	
	Examiner	Art Unit	
	Monique R. Jackson	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 10/16/06 has been entered. New claim 23 has been added. Claims 1-23 are pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

3. Claims 1-22, and newly recited Claim 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement, for the reasons recited previously and restated below. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. With respect to Claim 23, the Examiner notes that the claim is directed to a method of testing a coating but fails to provide any clear process steps other than “providing a coating” and “determining” if the coating provides certain properties with respect to known standard testing procedures. Hence, the Examiner takes the position that the invention of Claim 23 is directed to the coated article and not a testing process. Claims 1-23 are directed to an article comprising a transparent coating wherein the coating is broadly described as one that exhibits particular properties in terms of elasticity and scratch resistance, however, the instant disclosure provides no guidance to one skilled in the art as to how to select from an infinite number of coating components in order to produce the claimed relative elastic resilience and scratch resistance. In reviewing the specification, it is noted that the Applicant recites that “suitable coating materials are selected such that the coatings produced from them have the properties essential to the invention”,

Art Unit: 1773

wherein the solids content of the coating “may vary very widely and is guided by the requirements of the case in hand”, the amount of functional groups in the polymers and oligomers (A) “may vary widely and is guided by the requirements of the case in hand”, the amount of copolymer (A) “may vary widely and is guided by the requirements of the case in hand”, the amount of surface-modified inorganic nanoparticles (B) “may vary widely and is guided by the requirements of the case in hand”, the amount of amphiphiles (C) “may vary very widely and is guided by the requirements of the case in hand”, and that each component (A), (B), and (C) may be selected from a vast number of possibilities, including various disclosed and undisclosed components. Though the Applicant later recites weight percentage ranges for the three components A, B and C, the Applicant fails to provide any teaching or guidance as to how one skilled in the art could select from an infinite number of possible combinations of A, B, and C, in order to produce a coating with the claimed properties without undue experimentation particularly since the properties of the cured coating are not only a result of the coating composition but also the curing conditions. Hence, given the level of unpredictability in the art and the infinite combination of coating components, even with the further component limitations of dependent claim 15, the Examiner takes the position that the instant disclosure does not describe the subject matter in a way that one skilled in the art could make the invention without performing undue experimentation to determine what functional oligomer/polymer, what surface modified particles, what amphiphile, and what curing conditions would produce the claimed relative elastic resilience and scratch resistance.

Response to Arguments

4. Applicant's arguments filed 10/16/06 have been fully considered but they are not persuasive. The Applicant argues that the presently claimed "applying a coating on an article and measuring the coating's relative elastic resilience and scratch resistance involves straightforward application and testing techniques" and that the experimentation required is therefore "not undue, and the claims are enabled." However, the Examiner notes that the undue experimentation is not with regards to the testing method but with regards to the selection of the particular composition components and curing conditions in order to obtain a cured coating having the claimed relative elastic resilience and claimed scratch resistance, as discussed in detail above. Hence, considering the Applicant has not provided any guidance to one having ordinary skill in the art as to how they could select from an indefinite number and combination of functional oligomer/polymers, surface modified particles, amphiphiles, and curing conditions to arrive at a cured coating having the claimed properties, the Examiner maintains her position that given the level of unpredictability in the art, the instant disclosure does not describe the subject matter in a way that one skilled in the art could make the invention without performing undue experimentation.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

Art Unit: 1773

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R. Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Monique R. Jackson
Primary Examiner
Technology Center 1700
January 8, 2007